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DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)
09/833,743	KLASEN ET AL.
Examiner	**Art Unit**
Shean C. Wu	1756

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1.☒ Notice of References Cited (PTO-892)

2.☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3.☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4.☐ Interview Summary (PTO-413) Paper No(s). _____

5.☐ Notice of Informal Patent Application (PTO-152)

6.☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless
>
> (e) the invention was described in
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)
>
> (f) he did not himself invent the subject matter sought to be patented.

2. Claims 1-17 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. See the rejections under sections 3 and 4 below.

3. Claims 1-4, 7-11 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipates by Ichinose et al. (US 6,066,268).

The reference discloses a liquid crystalline medium based on a mixture of polar compounds having negative dielectric anisotropy, which comprises at least one compound of formula I and at least one compound of formula II. The liquid crystalline medium is useful for active matrix display device based on the ECB effect. The formulae I and II read on the compounds of the present formulae II, I2 and II. The additional compounds of formula IV are also disclosed on col. 4, which read on the present compound of formula III. The concentration ranges of each component is taught on col.

8, lines 22-41. See Example 2 on col. 12, which anticipates the claimed medium. Also, see the claims.

Claim Rejections - 35 USC § 103

4. Claims 5-6 and 13 are rejected under 35 U.S.C. 103(a) as being obvious over Ichinose et al. (US 6,066,268).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Ichinose differs from the present claims in that the claims comprise at least three compounds of formula II and I2 with at least 10 wt. % of formula I2. Although the numbers of compounds and the concentration ranges are not exemplified by the reference, it would still been obvious to those skilled in the art to optimize mixture of the reference to arrive at the claimed invention because the compound s and ranges are all disclosed by the reference (see col. 8, lines 22-41).

5. Claims 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Ichinose et al. (US 6,066,268) as applied to claims 1-11, 13-17 above, and further in view of Heckmeier et al. (US 6,217,953).

Ichinose differs from the claim in that the claim comprises additional compound represented formulae in Claim 12. Heckmeier teaches the liquid crystal medium comprising the present compounds represented by the formula IA and IB on col. 6. Because the liquid crystal medium of Heckmeier and the present invention comprising the similar component and having a negative dielectric anisotropy are useful in the MLC display device, it would have been obvious to those skilled in the art to add an additional compound of Heckmeier into liquid crystal medium of Ichinose to arrive at the claimed invention.

6. Claims 1-11 and 13-17 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yanai et al. (US 6,395,353).

The reference discloses a liquid crystal composition containing component I consisting of at least one compound of the compounds (I), component II consisting at least one compound of the compounds (II) and component (III) consisting of at least one compound of the compounds (III-1) and (III-2). The liquid crystal compositions have an appropriate refractive index anisotropy, a low viscosity, a large negative dielectric constant anisotropy, a wide nematic liquid crystal phase range and a high voltage holding rate, while satisfying various properties required for active matrix liquid crystal display devices, and can give display devices with a wide viewing angle.

Example 9 of the reference reads on the present claims 1, 3, 5, 10, 14-15 and 17 (see HCF2OBB(2F, 3F)-O2, 3-HB-O2 and V-HH-3). If other claims in the present invention are not anticipated, it would have been obvious to those skilled in the art to optimize the disclosed compounds and their ranges to arrive at the claimed invention. The compounds of formula II of the present invention are disclosed and used in Examples 23 and 24. These Examples also contain higher concentration of the present formula III.

Double Patenting

7. Claims 1-11 and 13-17 are directed to an invention not patentably distinct from claims 1-5, 7-12, 14, 16-17 and 19 of commonly assigned us 6,066,268. Specifically, the claimed medium between the US '268 and the present application overlap each other.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned us 6,066,268, discussed above, would form the basis for a rejection of the

noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-4, 7-11 and 14-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7-12, 14, 16-17 and 19

of US 6,066,268. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims between the present claims and US '268 overlap each other.

10. The present application has a potential interference with US 6,395,353.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C Wu whose telephone number is 703-308-3956. The examiner can normally be reached on Monday-Friday 9:30 -6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Shean C Wu
Primary Examiner
Art Unit 1756

scw
August 11, 2002